

PATENT**Application # 10/685,819****Attorney Docket # 2002P20757US01 (1009-027)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 5, 11, 14, and 17-20 has been amended for reasons unrelated to patentability, including at least one of: correct an informality, to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 5, 8, 11, 14, and 17 are in independent form.

I. The Anticipation Rejections

Each of claims 1-7 and 14-16 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, Hyatt (U.S. Patent No. 5,485,590) was cited. These rejections are respectfully traversed.

Each of claims 11-13 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, Alvarez-Escurra (U.S. Patent No. 5,923,903) was cited. These rejections are respectfully traversed.

As an initial matter, the present Office Action appears to be improperly structured. The present Office Action purports to reject each of claims 2, 3, 4, 6, 7, 15, and 16 under 35 U.S.C.

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102(b) in view of Hyatt. Yet the arguments allegedly rejecting these claims is presented in a section of the Office Action purported to reject each of claims 8-10, 11-13, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Alvarez-Escurra and/or McBride (U.S. Publication No. 2001/0034728 A1). Applicant assumes for the purposes of this Reply that the arguments related to the alleged rejections of each of claims 2, 3, 4, 6, 7, 15, and 16 were improperly placed on Pages 7-8 instead of on Page 5 of the present Office Action.

Hyatt fails to establish a *prima facie* case of anticipation. *See* MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.") The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

Specifically, *inter alia*, each of independent claims 1, 5, and 14, from one of which claims 2-4, 6, 7, 15, and 16 depend, recite "a structure of a data log file stored separately from the data log file," "the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time". Hyatt does not teach expressly or inherently "a structure of a data log file

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stored separately from the data log file,” “the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time”. Accordingly, it is respectfully submitted that the rejection of claims 1, 5, and 14 is unsupported by Hyatt and should be withdrawn. Also, the rejection of claims 2-4, 6, 7, 15, and 16, each ultimately depending from one of independent claims 1, 5, or 14, is unsupported by Hyatt and also should be withdrawn.

Inter alia, independent claims 11 from which each of claims 12 and 13 depends, recites “a structure of a data log file stored separately from the data log file,” “the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time”. Alvarez-Escurra does not teach expressly or inherently “a structure of a data log file stored separately from the data log file,” “the structure of the data log file describing a location in the data log file of each of a plurality of identifying stamps, each identifying stamp comprising at least one of a calendar date and a clock time”. Accordingly, it is respectfully submitted that the rejection of claim 11 is unsupported by Alvarez-Escurra and should be withdrawn. Also, the rejection of claims 12 and 13, each ultimately depending from independent claim 11, is unsupported by Alvarez-Escurra and also should be withdrawn.

II. The Obviousness Rejections

Each of claims 8-10 and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Alvarez-Escurra and/or McBride. These rejections are respectfully traversed.

A. *Prima Facie* Criteria

The cited portions of the applied references do not establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met.

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First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

"To establish prima facie obviousness..., '[a]ll words in a claim must be considered....'" MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

B. Claims 8-10

Claim 8, upon which each of claims 9 and 10 depends, recites, *inter alia*, yet the applied portions of Alvarez-Escurra do not teach or suggest, expressly or inherently, "prompting a user to select a language to display, on a user interface device connected to the PLC, information relating to a project file stored in the memory cartridge coupled to the PLC".

The present Office Action alleges, at Page 5, regarding claim 8, *inter alia*, that "Alvarez-Escurra teaches a method for utilizing a memory cartridge connected to a PLC ... prompting a user on a user interface device connected to the PLC (see col. 3 lines 27-38, 'language interface')", information relating to a project file stored in the memory cartridge coupled to the PLC (see col. 3 line 58 to col. 4 line 21)".

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Applicant respectfully submits that the present rejection of claim 8 fails to comply with MPEP 2143.03. Where does the present Office Action even allege that the relied upon portions of Alvarez-Escurra teach or suggest “prompting a user to select a language to **display**, on a user interface device connected to the PLC, **information relating to a project file stored in the memory cartridge coupled to the PLC**”? Applicant respectfully submits that under MPEP 2143.03, the present Office Action fails to establish *prima facie* obviousness.

Moreover, instead of teaching or suggesting the subject matter alleged in the present Office Action, the first relied upon portion of Alvarez-Escurra allegedly recites, at col. 3, lines 27-38:

[t]he user program is broken down into tasks. A task is a set of instructions periodically executed by the processing unit processor P. The manufacturer's program activates the inputs-outputs manager I before executing a task in order to acquire information originating from a logical channel. At the end of the task, the manufacturer's program activates the inputs-outputs manager (mark I on the FIG. 1) to make it send information to the logical channel. A data structure is associated with each logical channel of a given coupler (see FIGS. 2 to 4), that we will call language interface.

Applicant respectfully asks where does this relied upon passage teach or suggest, expressly or inherently, “prompting a user” for anything? How does the alleged “**data structure**” that is termed by Alvarez-Escurra as a “call language interface” teach or suggest, expressly or inherently, “prompting a user to select a language to display, on a user interface device connected to a PLC, information comprising a project file stored in the memory cartridge connected to the PLC”? Applicant respectfully submits that the claimed subject matter simply is not present in Alvarez-Escurra.

The present Office Action attempts to cure the deficiencies of Alvarez-Escurra with a combination with McBride. The relied upon portion of McBride allegedly recites:

[f]or example, the user may be provided with an **explanation and promotion of the mirroring software and an animated tutorial**. “Wizards” will preferably walk the user through the installation in a step-by-step fashion. The installation

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software will automatically detect the desired language based on the language of the operating system, i.e., the software will detect if the computer's operating system is using English, Spanish, Japanese, etc. If the operating system language is not supported, the software will prompt the user to select a language from among a list of supported languages.

Applicant respectfully asks how “an explanation and **promotion of the mirroring software and an animated tutorial**” allegedly recited by McBride teaches or suggests, expressly or inherently, “prompting a user to select a language to display, on a user interface device connected to a PLC, information comprising a project file stored in the memory cartridge connected to the PLC”. Accordingly, Applicant respectfully submits that McBride fails to overcome the deficiencies of Alvarez-Escurra.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the cited references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the cited references (another assumption that is respectfully traversed), the applied portions of the cited references, **as attempted to be modified and/or combined**, still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

C. Claim 17

Claim 17, upon which each of claims 18-20 depends, recites, *inter alia*, yet the applied portions of Alvarez-Escurra do not teach or suggest, expressly or inherently, “prompting a user to select a language to display, on a user interface device connected to a PLC, information comprising a project file stored in the memory cartridge connected to the PLC”.

The present Office Action alleges, at Pages 6-7, regarding claim 17, *inter alia*, that “Alvarez-Escurra teaches a method for utilizing a memory cartridge connected to a PLC ...

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prompting a user on a user interface device connected to the PLC (see col. 3 lines 27-38, 'language interface')", information relating to a project file stored in the memory cartridge coupled to the PLC (see col. 3 line 58 to col. 4 line 21)".

Applicant respectfully submits that the present rejection of claim 17 fails to comply with MPEP 2143.03. Where does the present Office Action even allege that the relied upon portions of Alvarez-Escurra teach or suggest "prompting a user to select a language to **display**, on a user interface device connected to a PLC, **information comprising a project file stored in the memory cartridge connected to the PLC**"? Applicant respectfully submits that under MPEP 2143.03, the present Office Action fails to establish *prima facie* obviousness.

Moreover, instead of teaching or suggesting the subject matter alleged in the present Office Action, the first relied upon portion of Alvarez-Escurra allegedly recites, at col. 3, lines 27-38:

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Applicant respectfully asks where does this relied upon passage teach or suggest, expressly or inherently, "prompting a user" for anything? How does the "**data structure**" that is termed by Alvarez-Escurra as a "call language interface" teach or suggest, expressly or inherently, "prompting a user to select a language to display, on a user interface device connected to a PLC, information comprising a project file stored in the memory cartridge connected to the PLC"? Applicant respectfully submits that the claimed subject matter simply is not present in Alvarez-Escurra.

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Thus, even if there were motivation or suggestion to modify or combine the applied portions of the cited references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the cited references (another assumption that is respectfully traversed), the applied portions of the cited references, **as attempted to be modified and/or combined**, still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

D. No Motivation or Suggestion to Combine Applied References

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. According to the Federal Circuit the "mere fact that the prior art

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may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

Instead, “**obviousness requires proof** ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Scott E. Johnston* (Fed. Cir. 30 January 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (emphasis added)). To make that proof, the Office Action must present sufficient evidence of some “‘suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to’”:

1. “‘select the references’”;
2. “‘select the teachings of [the] separate references’”; and
3. “‘combine [those teachings] in the way that would produce the claimed invention’”.

Id. See also *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (discussing the “the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

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Moreover, “[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to **suggest the desirability**, and thus the obviousness, of making the combination.” *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

The Office Action presents **no evidence of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**.” Instead, regarding the proffered combinations, the present Office Action merely states, at Page 6 and Page 7, that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the selection of languages by a user of McBride with the system of Alvarez-Excurra **because it would provide a user interface with information that can be read by the user not with a translator.**”

Moreover, the Office Action presents **no evidence** of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed invention”.

Thus, the Office Action fails to present the required **proof** of obviousness. Consequently, Applicant respectfully requests withdrawal of the obviousness rejections of claims 8-10 and 17-20.

E. Obviousness Summary

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

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A potential statement of reasons for the indication of allowable subject matter is:

“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-7 and 11-16 are allowable because none of the references of record alone or in combination disclose or suggest ‘the structure of the data log file comprising an identifying stamp, the identifying stamp comprising at least one of a calendar date and a clock time’;

claims 8-10 are allowable because none of the references of record alone or in combination disclose or suggest ‘prompting a user to select a language to display, on a user interface device connected to the PLC, information relating to a project file stored in the memory cartridge coupled to the PLC’; and

claims 17-20 are allowable because none of the references of record alone or in combination disclose or suggest ‘prompting a user to select a language to display, on a user interface device connected to a PLC, information comprising a project file stored in the memory cartridge connected to the PLC.’”

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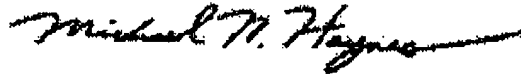
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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